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Date: 14 Jul 2006

To: Patricia A. Wenger	From: Ricky L. Mack
Application/Control Number: 10/648,508	Art Unit: 2873
Fax No.: 877-369-2792	Phone No.: (571) 272-2333
Voice No.: 610-566-3040	Return Fax No.: (571) 273-8300
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Number of pages 10 **including this page**

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DETAILED ACTION

Election/Restrictions

1. In response to the restriction requirement filed Jan. 3, 2006, the applicant elects claims 34-38, 46-73 and 77-84 for examination without prejudice. Claims 74-76 and 85 are withdrawn from consideration as being non-elected invention. As of record, the interview summary, paper # 1205 mailed Jan. 5, 2006 indicates that it was agreed that Applicant would be called once there is a determination of allowability for all examined claims to provide Applicant the opportunity to amend withdrawn claims 74-76 and 85 to depend from an allowed examined claims provided that there are not any 112 issues resulting from such an amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36, 37 and 46-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "said lens further comprising peripheral member" (claim 36, line 2) is indefinite because the lens and the peripheral member are two separate elements. The lens cannot comprise the peripheral member since they are two separate elements. The limitation "said lens further comprising at least one memory member" is also indefinite for similar reasoning.

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Regarding claims 46 and 78, the phrase “*consisting essentially of ...*” was held to be indefinite because the specification contains guidelines that were considered sufficient to enable a person of ordinary skill in the art to draw a line of distinction between the impracticality of using the rotatable lens in the air, such as airplane pilot eyewear, and using a rotatable lens in the sea, such as for deep sea diving, as claimed (In re Marosi, 710 F.2d 799, 218 USPQ 289 (CCPA)). The court further observed that it would be impractical to require applicant to specify a particular number as a cutoff between their invention and the prior art.

The remaining claims are dependent upon the above rejected base claims and thus inherit the deficiency thereof.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 34-36 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Erhard (1,401,327).

Regarding claims 34-36, Erhard (Figs 1-4, page 1, column 1, line 38 through column 2, line 69) discloses eyeglasses comprising a lens 5-8 and a peripheral member 2 wherein friction between the user's finger and the edge of the lens causes the lens rotate relative to the peripheral member 2 and thus, Erhard's eyeglasses inherently included a rotator and/or a turning member.

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Regarding claim 46, Erhard discloses an eyewear system comprising a containment structure 2, at least one lens 5-8 being rotatable within the containment structure 2 wherein the friction between the user's finger and the edge of the lens causes the lens rotate relative to the peripheral member 2 and thus, the Erhard's eyeglasses inherently include a rotator.

6. Claims 38, 46, 47, 49 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Karasawa (5,663,779).

Regarding claim 38, Karasawa discloses, in Fig.6, the lens 56 comprising an anchor cut-out 104.

Regarding claim 46, 47, 49 and 50, Karasawa discloses in Figs. 5-10, a configurable eyewear system, said eyewear system comprising at least one containment structure 11 and at least one lens 56, said at least one lens being rotatable within said containment structure, said eyewear system further comprising at least one rotator (102, 243), and said at least one lens being rotatable at least by said rotator.

7. Claims 46, 51-55, 77, 78 and 80-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey (1,471,996).

The limitations in claims 46, 51-55, 77, 78 and 80-84 are shown in Bailey's Figs. 1-7, pages 1-2. Bailey discloses a configurable eyewear system, said eyewear system comprising at least one containment structure 7 and at least one lens 1, said at least one lens being rotatable within said containment structure, said eyewear system further comprising one turning member 4, said at least one lens being rotatable at least by said turning member 4, said system further comprising at least one peripheral member 3, said turning member 4 being attached to said

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peripheral member 3, wherein said at least one lens further comprises a peripheral edge, said peripheral edge having at least one mating member, said at least one peripheral member 3 having at least one mating member, and said peripheral member mating member engaging said peripheral edge mating member (see Fig. 6).

Regarding claims 51 and 80, the containment structure including the bridge and/or guide 8 wherein the operating member 9 slides the turning member 4 between first position (see Fig. 3) and the second position (see Fig. 4) and thus, the guide 8 inherently includes a stop member.

8. Claims 77 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Archambault (2,813,459).

The limitations in claims 77 and 80 are shown in Archambault's Figs. 1-7, columns 1-2. Archambault discloses an eyewear system comprising a containment structure 7 and at least one lens 13 rotatable within the containment structure wherein the containment includes two stop members (see Fig.3).

9. Claims 34, 37, 46, 57, 58, 62 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Tassier (5,956,114).

Regarding claim 34 and 46, the limitations in claims 34 and 37 are readable over Tassier's Figs. 1, 4 and 8. Tassier discloses an eyewear lens 11 freely rotatable within the frame

2. Any shaking, touching or pushing on the surface of the lens causes the lens to rotate. Thus surface of the lens can be considered a rotator.

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Regarding claims 37, 57, 58, 62, 64 and 72, the magnetic means 15 and 17, in Tassier's Fig. 8, magnetically attaches to each other and pulls the lens back to the lens' original position and thus, the magnets do the function as a memory member.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 48 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erhard.

Erhard discloses a configuration eyewear system comprising at least one containment structure 2 and at least one lens being rotatable within the containment structure 2 wherein the containment structure has an interior surface and the lens has a peripheral edge (see Fig. 4). The interior surface and the peripheral edge have complement shapes. Although the interior surface and the peripheral edge in the Erhard's eyewear system does not teach the exact the shape of bezel as claimed by applicant, the shape, size and dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Erhard reference's interior surface and the peripheral edge having the same shape as the applicant's. Such a modification would have no functional differences from the Erhard reference.

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12. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Archambault in view of Hirschman (6,227,666).

Archambault discloses the claimed invention as discussed above. Archambault is silent as to how the lens 13 is mounted in the ring 12. A lens mounted in a ring or rim by a split rim mounting is commonly known in the art as taught by Hirschman. For example the rim is split with two ends having projections connecting together after mounting the lens. It would have been obvious to those having ordinary skill in this art at the time the invention was made to modify the Archambault's device by forming a split at the projection 18 for mounting the lens 13 in the rim 12, as is common knowledge in the art. Such a modification would not change the scope of the invention disclosed by Archambault.

13. Claims 65-69 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tassier.

Regarding claims 65-69, without showing the new or unobvious results and the reasons why the connector comprised of gluing, molding, heat sealing, tacking or an anchor insert for connecting the memory means to the lens, it would have been an obvious engineering choice to form such connectors for connecting the memory means to the lens.

Regarding claim 73, without showing the new or unobvious results and the reasons why the memory means has an anchor end, it would have been an obvious engineering choice to form such an anchor end for attaching the memory means to the lens.

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Allowable Subject Matter

14. Claims 59, 60, 61, 63, 70 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai

Primary Examiner

Art Unit 2873

HKM/

July 14, 2006